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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,617	04/25/2005	Wenlong Deng	53624/DBP/C306	1639
23363 7590 09/26/2007 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			EXAMINER CLARK, AMY LYNN	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/510,617

Applicant(s)

DENG, WENLONG

Examiner

Amy L. Clark

Art Unit

1655

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 11-16.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
MICHELE FLOOD  
PRIMARY EXAMINER

ALC  
AU 1655

Continuation of 11. does NOT place the application in condition for allowance because: The rejections are maintained for reasons of record.

Applicant's arguments with regards to the 35 USC 103(a) rejection of claims 11-16 as being unpatentable over Xu et al., in view of Li et al. (V, CN 1051859 A, Abstract only), Xiong et al. (W, CN 1097313 A, Abstract only), Wang (X, CN 1146348 A, Abstract only), Green (U1, "The Herbal Medicine-Maker's Handbook: A Home Manual. 2000, Berkeley, California: The Crossing Press. Pages 109, 112-114, 146, 151, 299, 309 and 310), Hu et al. (V1, Se Pu. 1999; 17(3): 265-267. Abstract only), Li (W1, Hua Xi Yi Ke Da Xue Xue Bao. 1995; 26(1): 66-69. Abstract only), Xie (X1, Se Pu. 1997; 15(1): 54-56. Abstract only) and Zhang (U2, ZhongXu Zhong Yao Za Zhi. 1998; 23(9):549-550. Abstract only) are as follows. Applicant argues that the Examiner has selected bits and pieces from disparate disclosures while ignoring other key ingredients taught by the references to arrive at the present invention through hindsight reasoning.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, it should be noted that Applicant has used the claim language "comprising", which is open claim language, and, therefore, other ingredients may be added to the composition. Therefore, compositions taught in the prior art that contain more than just the ingredients claimed by Applicant are acceptable, since Applicant's claims are open.

Applicant further argues that efficacy and safety are important and that the Examiner has not pointed to anything that would direct the skilled person in the art to make a medicinal formulation containing the four claimed herbs and that although there are vast numbers of Chinese herbal medicines and treatments, that the prior art suffers from poor or mixed efficacy, often deleterious side effects and sometimes difficult administration.

In response to this argument, Applicant has not provided any evidence to support this argument by demonstrating that the medicinal compositions found in the prior art have the negative effects that Applicant is arguing they have. Since the prior art taught that each of these herbs claimed by Applicant can be used to treat rheumatism and may be combined, the rejection is maintained. It appears that Applicant has attempted to supply data with Applicant's arguments regarding testing the effect of each of the individually claimed herbs on mouse testicles; however it is unclear how this relates to treating rheumatism, which is a disease of the joints. Furthermore, this data was not supplied as an affidavit or declaration and is, therefore, not being considered by the Examiner since it was not properly or appropriately submitted by Applicant. Applicant is directed to the MPEP for the proper way to submit an affidavit or declaration.

Finally, Applicant argues that the Examiner has not presented a prima facie case of obviousness.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has provided adequate reasoning both in the Office Action dated 04/17/2007 and for the reasons recited above.